



Dkt. 55672-A-PCT-US/JPW/BJA

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Gloria C. Li et al.
Serial No.: 09/750,410 Examiner: Jane Zara
Filed : December 28, 2000 Group Art Unit: 1635
For : USES OF DNA-PK

30 Rockefeller Plaza, 20th Flr.
New York, New York 10112

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

TERMINAL DISCLAIMER

Sloan-Kettering Institute for Cancer Research, ("Sloan-Kettering"), having a place of business at 1275 York Avenue, New York, NY, 10021, is the assignee of record of the entire right, title and interest in the above-identified application by virtue of an assignment recorded in the U.S. Patent and Trademark Office on August 9, 2002 at Reel No. 013181, Frames 0530-0532. A copy of the recorded assignment is attached hereto as Exhibit C.

Sloan-Kettering is also the assignee of record of the entire right, title and interest in U.S. Serial No. 10/712,642, filed November 12, 2003, which is a continuation of the above-identified application, by virtue of an assignment of U.S. Serial No. 09/750,410 recorded in the U.S. Patent and Trademark Office on August 9, 2002 at Reel No. 013181, Frames 0530-0532. A copy of the recorded assignment is attached

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hereto as Exhibit C.

Sloan-Kettering hereby disclaims, except as provided below, the terminal portion of the statutory term of any patent granted on the above-identified application which would extend beyond the expiration date of the full statutory term as defined in 35 U.S.C. §154 to §156 of a patent that issues from U.S. Serial No. 10/712,642 and hereby agrees that any patent issued from the subject application shall be enforceable only for and during such period that the legal title to such patent shall be the same as the legal title to any patent that issues from U.S. Serial No. 10/712,642, this agreement to run with any patent granted on the subject application and to be binding upon the grantee, its successors and assigns.

In making the above disclaimer, Sloan-Kettering does not disclaim the terminal portion of the term of any patent granted on the subject application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §154 to §156 and §173 of a patent that issues from U.S. Serial No. 10/712,642 in the event that such patent expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. §1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term.

I have reviewed the assignment attached hereto and certify

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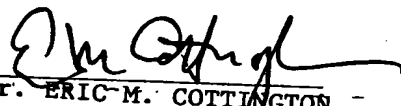
that, to the best of my knowledge and belief, Sloan-Kettering is the assignee of all right, title and interest in and to the subject application and to any patent that issues from U.S. Serial No. 10/712,642. I further certify that I am authorized to sign on behalf of Sloan-Kettering.

I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that any such willful false statement and the like so made is punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that any such willful false statement may jeopardize the validity of the application or any patent issuing thereon.

Date: 7-8-09

Sloan-Kettering Institute for
Cancer Research

By:


Dr. ERIC M. COTTI, -
VICE PRESIDENT,
RESEARCH AND TECHNOLOGY MANAGEMENT,
SLOAN KETTERING INSTITUTE FOR CANCER RESEARCH

Attachments

EXHIBIT C



UNITED STATES
PATENT AND
TRADEMARK OFFICE

OCTOBER 21, 2002

PTAS

Under Secretary of Commerce For Intellectual Property and
Director of the United States Patent and Trademark Office
Washington, DC 20231
www.uspto.gov

COOPER & DUNHAM LLP
JOHN P. WHITE, ESQ.
1185 AVENUE OF THE AMERICAS
NEW YORK, NEW YORK 10036



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OCT 23 2002

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UNITED STATES PATENT AND TRADEMARK OFFICE
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

RECORDATION DATE: 08/09/2002

REEL/FRAME: 013181/0530
NUMBER OF PAGES: 3

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

LI, GLORIA C.

DOC DATE: 01/19/2001

ASSIGNOR:

BURGMAN, PAUL W. J. J.

DOC DATE: 01/19/2001

ASSIGNEE:

SLOAN-KETTERING INSTITUTE FOR
CANCER RESEARCH
1275 YORK AVENUE
NEW YORK, NEW YORK 10021

SERIAL NUMBER: 09750410
PATENT NUMBER:

FILING DATE: 12/28/2000
ISSUE DATE:

DOROTHY BASMA, EXAMINER
ASSIGNMENT DIVISION
OFFICE OF PUBLIC RECORDS

08-15-2002

Docket No. 55672-A-PCT-US

JPW/AJM/AHM

U.S. DEPARTMENT OF COMMERCE

Patent and Trademark Office

FORM PTO-1595 (Substitute)

(Rev. 8-96)

To the Honorable Commissioner of Patents

102191054

original documents or copy thereof.

1. Name of conveying party(ies):

Gloria C. Li
Paul W.J.J. Burgman

AUG 0 9 2002

PATENT & TRADEMARK OFFICE

Additional name(s) of conveying party(ies) attached?

☐ Yes ☒ No

3. Nature of Conveyance:

- ☒ Assignment ☐ Merger
☐ Security Agreement ☐ Change of Name
☐ Other _____

Execution Date(s): January 19, 2001

2. Name and address of receiving party(ies):

Name: Sloan-Kettering Institute for
Cancer Research

Internal Address: _____

Street Address: 1275 York Avenue

City/State/Zip: New York, New York 10021

Additional name(s) & address(es) attached? ☐ Yes ☒ No

4. Application number(s) or patent number(s): If this document is being filed together with a new application, the execution date(s) of the application is(are): _____

A. Patent Application No(s) 09/750,410

Filed: December 28, 2000

B. Patent No(s) _____

Additional numbers attached?

☐ Yes ☒ No

5. Name and address of party to whom correspondence concerning document should be mailed:

Name: John P. White, Esq.

Internal Address: Cooper & Dunham LLP

Street Address: 1185 Avenue of the Americas

City/State/Zip: New York, New York 10036

6. Total number of applications and patents involved: 1

7. Total fee (37 CFR §3.41): \$ 40.00

☐ Enclosed☒ Authorized to be charged to deposit account

8. Deposit account number:

03-3125

08/15/2002 GTOM11 00000026 033125 09750410

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9. Statement and signature.

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.

Alan J. Morrison, Esq.

Name of Person Signing

Signature

Date

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231.

Alan J. Morrison
Reg. No. 37,399

Date

Total Number of pages including cover sheet, attachments and document: 3

OMB No. 0651-0011 (exp. 4/94)

Mail documents to be recorded with required cover sheet information to:
 Commissioner of Patents and Trademarks
 Box Assignments
 Washington, D.C. 20231

Assignment

In consideration of One Dollar (\$1.00), and other good and valuable considerations, the receipt of which is hereby acknowledged, I, the undersigned, Gloria C. Li residing at 345 E. 68th Street #5F, New York, New York 10021, USA; and Paul J.J. Burgman residing at 401 E. 63rd Street #15, New York, New York 10021, USA

Hereby sell, assign and transfer to Sloan-Kettering Institute for Cancer Research a corporation of the State of New York having a place of business at 1275 York Avenue in the County of New York and State of New York 10021 its successors, assigns and legal representatives, the entire right, title and interest for all countries, in and to any and all inventions which are disclosed and claimed, and any and all inventions which are disclosed but not claimed, in the application for United States Patent, which has been executed by the undersigned and is entitled

USES OF DNA-PK

(U.S. Serial No. 09/750,410, Filed December 28, 2000, a continuation of PCT International Application No. PCT/US99/14702, filed June 30, 1999, a continuation-in-part and claiming priority of U.S. Provisional Application No. 60/091,181, filed June 30, 1998)

and in and to said application and all divisional, continuing, substitute, renewal, reissue, and all other applications for U.S. Letters Patent or other related property rights in any and all foreign countries which have been or shall be filed on any of said inventions disclosed in said application; and in and to all original and reissued patents or related foreign documents which have been or shall be issued on said inventions;

Authorize and request the Commissioner of Patents of the United States to issue to said Assignee, the corporation above named, its successors, assigns and legal representatives, in accordance with this assignment, any and all United States Letters Patent on said inventions or any of them disclosed in said application;

Agree that said Assignee may apply for and receive foreign Letters Patent or rights of any other kind for said inventions, or any of them; and may claim, in applications for said foreign Letters Patent or other rights, the priority of the aforesaid United States patent application under the provisions of the International Convention of 1883 and later modifications thereof, under the Patent Cooperation Treaty, under the European Patent Convention or under any other available international agreement; and that, when requested, without charge to, but at the expense of, said Assignee, its successors, assigns and legal representatives, to carry out in good faith the intent and purpose of this assignment, the undersigned or the undersigned's executors or administrators will, for the United States and all foreign countries execute all divisional, continuing, substitute, renewal, reissue, and all other patent applications or other documents on any and all said inventions; execute all rightful oaths, assignments, powers of attorney and other papers; communicate to said Assignee, its successors, assigns and representatives, all facts known and documents available to the undersigned relating to said inventions and the history thereof; testify in all legal proceedings; and generally do everything possible which said Assignee, its successors, assigns or representatives shall consider desirable for aiding in securing, maintaining and enforcing proper patent protection for said inventions and for vesting title to said inventions and all applications for patents or related foreign rights and all patents on said inventions, in said Assignee, its successors, assigns and legal representatives; and

Covenant with said Assignee, its successors, assigns and legal representatives that no assignment, grant, mortgage, license or other agreement affecting the rights and property herein conveyed has been made to others by the undersigned, and that full right to convey the same as herein expressed is possessed by the undersigned.

Date: 1/19/2001 Gloria C. Li [L.S.]

Witness: Patricia Kuehner
Patricia Kuehner
335 E 65th St #1B
New York NY 10021

Date: January 19, 2001

Witness: Vera Hincle
Vera Hincle
45 Brooklyn Avenue
W. Hempstead, NY 11552

P.B.-g- [L.S.]

Paul J.J. Burgman

Paul W.-J.-J. Burgman P.B.

ASSIGNMENT
BY

GLORIA C. LI
PAUL W.J.J. BURGMAN

TO

SLOAN-KETTERING INSTITUTE FOR
CANCER RESEARCH

Application for Letters Patent
of the United States for:

USES OF DNA-PK

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